

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD CROUSE

Appeal No. 96-1901
Application 07/925,790¹

ON BRIEF

Before COHEN, ABRAMS and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 2-4 and 7-10. As for the remaining claims of record, claim 1 has been canceled and appeal has not been taken from the final rejection of claims 5 and 6. No claims have been allowed.

¹ Application for patent filed August 7, 1992. According to appellant, this application is a continuation-in-part of Application 07/601,497, filed October 23, 1990, now abandoned.

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The appellant's invention is directed to a portable apparatus for pulling flexible well pipe (claims 2-4, 7 and 8), and to a method of removing flexible pipe from a well (claims 9 and 10). The claims on appeal have been reproduced in an appendix to Paper No. 27, with errors noted by the examiner in Paper No. 28.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Parola	3,168,287	Feb. 2, 1965
Haines	3,635,441	Jan. 18, 1972
Crees	3,809,366	May 7, 1974

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 2, 3 and 8-10 on the basis of Parola and Haines.
- (2) Claims 4 and 7 on the basis of Parola, Haines and Crees.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the

claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Brief. We have evaluated the rejections on the basis that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The appellant's invention is concerned with managing the removal of flexible well pipe from a well bore. We shall focus our detailed analysis on independent claim 2, which is representative of the invention. This claim is directed to the combination of a flexible well pipe, a well pipe hoisting means, actuation means for rotating the hoist means, and mounting means for mounting the hoisting means and the actuation means over the well. The well pipe hoisting means comprises

opposed, circular discs carried on an axle, each of said discs having convex, pipe-engaging surfaces frictionally engaged with said flexible well pipe . . . wherein said flexible well pipe is bent between and wrapped over the convex, pipe-engaging surfaces to be frictionally engaged therewith and thereby pulled upwardly by the hoisting means upon actuation of the actuation means.

It is the examiner's position that all of the structure recited in claim 2 is disclosed by Parola, except for the circular discs, which are taught by Haines, and that it would have been obvious to

one of ordinary skill in the art to replace the drum winding mechanism of Parola with one that utilized opposed convex discs, as is Haines, “because the discs would allow a smaller, more portable apparatus” (Answer, page 5).

We agree with the examiner that, insofar as the language of the appellant’s claim 2 is concerned, only the discs are lacking from the Parola disclosure. In Parola, the flexible well pipe is wrapped several times around a drum, with such multiple wrappings providing the necessary friction for holding the flexible pipe as it is raised and lowered. According to Parola the prior art conventional cylindrical drums allowed the flexible pipe to flatten under certain tension and bending-torsional forces, which constricted the flow therethrough (column 1). Parola solves this problem by providing elastic mattresses with cellular chambers (16, 17, 18) corresponding to the three turns of the flexible pipe around the drum, which cushion and support the flexible pipe to prevent flattening (column 3). Parola is mentioned in the appellant’s specification as an example of the prior art devices over which his invention is an improvement (specification, page 2).

Haines discloses an apparatus for pulling a long commercial fishing line across a boat. Included in the system is a sheave comprising a pair of opposed convex discs (39, 41) which are biased toward one another by a pair of springs (54, 61), and are mounted on an axle (43) rotatable by a motor (23). In order to maintain a tension on the fishing line, Haines teaches that it is “squeezed between” the discs, which are “clamped tightly” together by the springs (column 4, lines 10-16). To achieve this

relationship between the discs and the fishing line, the discs are canted apart at the bottom by a pair of rollers (75, 76), so that the fishing line is introduced between spaced surfaces of the discs, and is then clamped by these surfaces as they rotate and the space is eliminated (column 4). Thus, the Haines system differs from that of the appellant's invention in that it operates upon a thin line, which has essentially no surface area, rather than on a flexible pipe, which has a considerable surface area, and places tension upon the line by clamping it between the discs rather than by controlling the amount of surface area of the pipe that contacts the discs.

The mere fact that a prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There must be some reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). Here, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Parola system in the manner proposed by the examiner.

We arrive at this conclusion for several reasons. First of all, there simply is no teaching in Haines which would, in our view, have suggested to one of ordinary skill in the art that the Haines discs could be used with flexible pipe. Second, in accordance with the Haines system, the flexible pipe would be clamped between the discs with pressure applied by the springs, and therefore could be crushed, resulting in the flow of fluids therethrough being curtailed or greatly impeded, thus making it dysfunctional for the Parola situation. Third, substitution of the discs for the chambered drum of Parola would destroy the Parola invention. All of these factors would have operated as disincentives to the artisan to make the proposed modification.

We therefore are of the opinion that the combined teachings of Parola and Haines fail to establish a *prima facie* case of obviousness with respect to the subject matter recited in independent claim 2, and we will not sustain the rejection.

For the same reasons, we also will not sustain the rejection of independent claims 3, 9 and 10, all of which recite the discs, and all of which also stand rejected on the basis of Parola and Haines. In addition to the disc limitation, method claims 9 and 10 require the step of controlling the engagement of the well pipe with the discs by “raising and lowering the well pipe on the side of the apparatus remote from the well,” which clearly not only is not taught by either of the applied references, but would be impossible to perform in either.

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The Crees patent, which was cited against several of the claims for its teaching of utilizing an electric hand drill to power a device which drives a flexible tube, does not overcome the problems set forth above with regard to the combination of Parola and Haines.

SUMMARY

Neither of the rejections is sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	APPEALS AND
NEAL E. ABRAMS)	INTERFERENCES
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JEFFREY V. NASE)	
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